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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,223	06/27/2001	Shane M. Kelton	163.1062USD1	5643

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EXAMINER
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DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/893,223

Applicant(s)

KELTON ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08-02-05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 37-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-35, 37, 43 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-42 and 45-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The 112 2<sup>nd</sup> paragraph over the language “new and untreated”, and “small” in the prior Office Action is withdrawn due to Applicant’s amendments.

#### ***Claim Objections***

1. Claims 38-42 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims do not constitute a further limitation because the claims do not refer to a preceding claim. See also MPEP 608.01 (n).

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 38-40 and 45-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term “substantially the same” is indefinite as the specification does not provide a definition to the metes and bounds of the phrase. In order to determine infringement of the present claims, one necessarily would need to determine with a reasonable degree of certainty the scope of the phrase “substantially the same.” Applicant has failed to provide any such guidance and, accordingly, this phrase renders the scope of the claims unclear.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 38-42 and 45-53 are rejected under 35 U.S.C. 102(b) as being anticipated over USPN 3,847,688 to Gillice in view of applicant's admissions.

Gillice teaches slip-resistant flooring tile, such as ceramic tiles (abstract, for instance). It is the Examiner's position that such tiles possess "small peaks and valleys," as presently claimed, since ceramics, by their very nature, are not perfectly smooth. This relative phrase is not seen to distinguish over the ceramic tiles of Gillice.

Regarding the phrase "substantially the same," with respect to the composition of the tile relative to the core, the Examiner notes that the word "substantially" is broad and applicant has failed to provide any definition of the scope of this term in the specification. Thus, it is the Examiner's position that the tiles of Gillice have "an elemental composition substantially the same as that of the core of a new, unused tile." Moreover, the Examiner notes that the prior art does not teach aged tiles and therefore, the instant claims read on unused tiles. Clearly then, such tiles have an elemental composition as presently claimed.

Regarding claims 38 and 49, as noted by applicant in the present application "ceramic tile," such as those disclosed by Gillice, are also referred to as "quarry tile" (specification at page

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1, lines 18-19, for instance). Therefore, it is the Examiner's position that Gillice teaches "quarry tile" as recited in claims 38 and 49.

With respect to claims 46 and 47-48, since the recited compositional ranges are merely descriptive of conventional quarry tile, such as those disclosed by Gillice, it is the Examiner's position that Gillice anticipates claims 46 and 47-48.

Finally, regarding the coefficients of friction recited in claims 39-42 and 50-53, it is the Examiner's position that the quarry tiles of Gillice necessarily possess the recited values, since the recited values are conventional for such flooring tiles having the same materials. The applicant discusses this aspect of such tiles in the instant specification at page 52, lines 11-15, for instance. Again, the Examiner notes that the present claims read on new, unused tile.

The Examiner notes that the portions of the specification cited above are merely indicated to demonstrate inherent properties of quarry tiles, such as those taught by Gillice.

6. Claims 38-42 and 45-53 are rejected under 35 U.S.C. 102(b) as being anticipated over USPN 5,111,627 to Brown in view of applicant's admission.

Brown teaches quarry tile having a surface, which may be employed in a tile floor (figures 1-4; col. 5, lines 26-27; and col. 8, lines 60-65, for instance). It is the Examiner's position that such tiles possess "small peaks and valleys," as presently claimed, since quarry tile, by their very nature, are not perfectly smooth. This relative phrase is not seen to distinguish over the quarry tiles of Brown.

Regarding the phrase "substantially the same," with respect to the composition of the tile relative to the core, the Examiner notes that the word "substantially" is broad and applicant has

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failed to provide any definition of the scope of this term in the specification. Thus, it is the Examiner's position that the tiles of Brown have "an elemental composition substantially the same as that of the core of a new, unused tile." Moreover, the Examiner notes that the prior art does not teach aged tiles and therefore, the instant claims read on unused tiles. Clearly then, such tiles have an elemental composition as presently claimed.

With respect to claims 46 and 47-48, since the recited compositional ranges are merely descriptive of conventional quarry tile, such as those disclosed by Brown, it is the Examiner's position that Brown anticipates claims 46 and 47-48.

Finally, regarding the coefficients of friction recited in claims 39-42 and 50-53, it is the Examiner's position that the quarry tiles of Brown necessarily possess the recited values, since the recited values are conventional for quarry flooring tiles having the same materials. The applicant discusses this aspect of such tiles in the instant specification at page 52, lines 11-15, for instance. Again, the Examiner notes that the present claims read on new, unused tile.

The Examiner notes that the portion of the specification cited above is merely indicated to demonstrate inherent properties of quarry tiles, such as those taught by Brown.

Because the tile of Brown is made of the components as Applicant claims, the claimed features would therefore be inherent (e.g. slip-resistant, COF, and floor surface). To claims 46-48 to the recited composition, because the same quarry tile is used, it inherently has the same elemental composition.

7. Claims 38-42 and 45-53 are rejected under 35 U.S.C. 102(b) as being anticipated over USPN 4,681,786 to Brown in view of Applicant's admission.

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Brown teaches quarry tile having a surface, which may be employed in a tile floor (figures 1-4; and col. 3, lines 22-24, for instance). It is the Examiner's position that such tiles possess "small peaks and valleys," as presently claimed, since quarry tile, by their very nature, are not perfectly smooth. This relative phrase is not seen to distinguish over the quarry tiles of Brown.

Regarding the phrase "substantially the same," with respect to the composition of the tile relative to the core, the Examiner notes that the word "substantially" is broad and applicant has failed to provide any definition of the scope of this term in the specification. Thus, it is the Examiner's position that the tiles of Brown have "an elemental composition substantially the same as that of the core of a new, unused tile." Moreover, the Examiner notes that the prior art does not teach aged tiles and therefore, the instant claims read on unused tiles. Clearly then, such tiles have an elemental composition as presently claimed.

With respect to claims 46 and 47-48, since the recited compositional ranges are merely descriptive of conventional quarry tile, such as those disclosed by Brown, it is the Examiner's position that Brown anticipates claims 46 and 47-48.

Finally, regarding the coefficients of friction recited in claims 39-42 and 50-53, it is the Examiner's position that the quarry tiles of Brown necessarily possess the recited values, since the recited values are conventional for quarry flooring tiles. The applicant discusses this aspect of such tiles in the instant specification at page 52, lines 11-15, for instance. Again, the Examiner notes that the present claims read on new, unused tile.

The Examiner notes that the portion of the specification cited above is merely indicated to demonstrate inherent properties of quarry tiles, such as those taught by Brown.

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8. Claims 38-42 and 45-53 are rejected under 35 U.S.C. 102(e) as being anticipated over USPN 5,797,986 to Rolando et al.

Rolando teaches a tile floor comprising quarry tile (abstract, for instance). It is the Examiner's position that such tiles possess "small peaks and valleys," as presently claimed, since quarry tile, by their very nature, are not perfectly smooth. This relative phrase is not seen to distinguish over the quarry tiles of Rolando.

Regarding the phrase "substantially the same," with respect to the composition of the tile relative to the core, the Examiner notes that the word "substantially" is broad and applicant has failed to provide any definition of the scope of this term in the specification. Thus, it is the Examiner's position that the tiles of Rolando have "an elemental composition substantially the same as that of the core of a new, unused tile." Moreover, the Examiner notes that the prior art does not teach aged tiles and therefore, the instant claims read on unused tiles. Clearly then, such tiles have an elemental composition as presently claimed.

With respect to claims 46 and 47-48, since the recited compositional ranges are merely descriptive of conventional quarry tile, such as those disclosed by Rolando, it is the Examiner's position that Rolando anticipates claims 46 and 47-48.

Finally, regarding the coefficients of friction recited in claims 39-42 and 50-53, it is the Examiner's position that the quarry tiles of Rolando necessarily possess the recited values, since the recited values are conventional for quarry flooring tiles. The applicant discusses this aspect of such tiles in the instant specification at page 52, lines 11-15, for instance. Again, the Examiner notes that the present claims read on new, unused tile. Moreover, Rolando discloses such coefficients of friction in claims 29 and 40.

The Examiner notes that the portion of the specification cited above is merely indicated to demonstrate inherent properties of quarry tiles, such as those taught by Rolando.

***Response to Arguments***

Applicant's arguments have been considered but are not persuasive.

Applicant argues that the renumbering of claims should not be changed by Applicant, but the Examiner. However, because the Examiner has notified the Applicant of the requirement as in 37 CFR 1.75(c) and MPEP 608.01 (n), it is suggested that Applicant make the corresponding changes.

Applicant argues that the meaning of “substantially the same” is noted by Applicant’s Table I in the instant specification on pgs. 50-51. However, this example is not a definition and does not define what “substantially the same” means. Again, the term “substantially the same” is indefinite as the specification does not provide a definition to the metes and bounds of the phrase.

Applicant argues the applied prior art cannot be new and unused tiles, however because all tiles of the cited prior art teach manufacturing the tiles, they must be new and the prior art does not teach they are aged. Applicant has also introduced new claims to quarry tile at the surface and core, however, because the same quarry tile is provided by the prior art, the claims read on the same quarry tile throughout.

Applicant argues the applied prior art does not show any elemental compositions, however, Applicant admits and claims the tile is of quarry material and therefore because the same material is provided, it contains the elemental compositions. Further, Applicant has not produced any objective evidence to the contrary.

Applicant argues his particular method shows “substantially the same” however, methods of making are not claimed and further not germane in patentability of product claims.

Applicant argues the petition to remove Rolando will be granted, however, the decision has not be made as of yet and thus pending the response to the petition the rejection is maintained.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

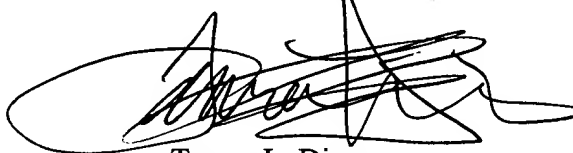
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

October 17, 2005



RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 10/28/05